

REMARKS

Claim 1-84 are pending.

Claims 1-84 are rejected under 35 USC §112, first paragraph, for failing to comply with the enablement requirement.

The latest office action, dated 17 March 2009, raises another rejection under the first paragraph of section 112. This time, the office action alleges that claims 1-84 are rejected under the enablement requirement because "the specification, while being enabling for EM wavelengths usable by solar cells, does not reasonably provide enablement for EM wavelengths outside of the range usable by solar cells."

The rejection is respectfully traversed. There is no legal basis for the '112 rejection.

On 11 June 2009, applicant's attorney Hugh Gortler (the undersigned) called Examiner Bernarr Gregory and asked him to identify the legal basis that he was using for the '112 rejection. The undersigned inquired whether the examiner was relying upon the MPEP and, if so, upon which section.

Examiner Gregory stated that he was not relying upon the MPEP. Instead, he was relying solely upon a plain reading of the statute 35 USC §112. Based on that reading, he said, the specification was non-enabling because it did not disclose structure for converting all wavelengths of an EM beam to electrical energy. Examiner Gregory is thanked for taking the time to discuss the '112 rejection with the undersigned.

Rejecting a claim solely on a plain reading of the statute is not proper. Statutes relating to patents are interpreted by the courts, and the U.S. Patent and Trademark Office applies the judicial interpretations to the rules that govern the conduct of the patent examiners (see MPEP Introduction). Those rules are found in the MPEP.

MPEP 2164.04 is entitled "Burden on the Examiner Under the Enablement Requirement." It states:

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims (citations omitted).

The office action does not allege that undue experimentation is required in order to make and use the claimed invention. To the contrary, it acknowledges that a person skilled in the art can use solar cells to convert an EM beam into electrical energy.

Instead, the office action alleges that the scope of enablement is not commensurate with the scope of protection sought by the claims.

MPEP 2164.08 is entitled "Enablement Commensurate in Scope With the Claims." It states

The focus of the examination inquiry is whether everything within the scope of the claim is enabled. Accordingly, the first analytical step requires that the examiner determine exactly what subject matter is encompassed by the claims. See, e.g., *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003)... The examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually... The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation.

However, instead of considering the scope of the claims as a whole, the office action focuses on the scope of a part (the converter). This is improper. The inquiry is not whether the specification enables a converter that can convert wavelengths outside of the range usable by solar cells. The inquiry is whether the specification enables a control system for a remote control vehicle (claims 1-22), a remote control vehicle

(claims 23-44), a remote-controlled vehicle operation system (claims 45-68), and a method for operating a remote-controlled vehicle (claims 69-84).

The office action inquires about wavelengths outside of a usable range. However, the inquiry is not important to the '112 rejection. MPEP 2164.08 further states:

How a teaching is set forth, by specific example or broad terminology, is not important.... Claims are not rejected as broader than the enabling disclosure under 35 U.S.C. 112 for noninclusion of limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious.

The application provides broad teachings (it describes the functionality) of the converter. These broad teachings allow a person skilled in the art to choose a converter having a "usable" range of wavelengths.

The office action appears to require the claims to be limited to solar cells operable in the range of 1.06 to 1.07 μm (claim 2 recites a photocell and claim 3 recites a solar cell, but they too are rejected as not being enabled). This is tantamount to requiring the claims to recite only a specific example in the application. However, the MPEP does not support this requirement. MPEP 2164.08 and MPEP 2164.08(a) state

To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

The specification provides support for the full scope of each base claim as a whole, including the conversion of an EM beam into electrical energy (page 6, lines 25+ offer examples of photocells). Therefore, the '112 rejection should be withdrawn.

The office action also objects to the specification for failing to teach one or ordinary skill in the art how to make and use the claimed invention. The objection is traversed for the reasons above.

The Examiner is encouraged to contact the undersigned to discuss any remaining issues before mailing another office action.

Respectfully submitted,

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